



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,691	12/17/2001	Richard Joseph Caballero	SBL0020US	2964
60975	7590	11/15/2007		
CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758			EXAMINER CHENCINSKI, SIEGFRIED E	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 11/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/024,691	Applicant(s) CABALLERO ET AL.	
	Examiner Siegfried E. Chencinski	Art Unit 3692 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/12/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-64 are rejected because the claimed invention is directed to non-statutory subject matter. Independent claims 1, 19, 36, 50, 64, 65 and 66 are not directed to any one of the areas of patentable subject matter, such as product, process, process of making or composition. Claims 2-18, 20-35, 37-49 and 51-63 are rejected because of their dependence on independent claims 1, 19, 36, 50, 64, 65 and 66. For a claim to be statutory under 35 USC 101 the following condition must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result.

According to the above guidelines, Applicant's claims are limited to the manipulation of abstract ideas in the context of patentability because the claim lacks an indication of usefulness. The amend independent claims still do not result in an action but merely in a software program which does not meet the requirements of patentable subject matter, such as product, process, process of making or composition under 35 USC 101. Software does not represent a useful, concrete, tangible result under this statute.

Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3692

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-64 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a clearly asserted utility or a well established utility for the reasons set forth above in the rejection of the claims under 35 USC 101, one skilled in the art clearly would not know how to use the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-64 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1, 19, 36, 50 and 64 fail to correspond in scope with that which applicant(s) regard as the invention can be found in the specification filed December 17, 2001. In that paper, applicant has stated the invention has the purpose of processing complex orders which include complex services and products, and this statement indicates that the invention is different from what is defined in the claim(s) because the independent claims do not include a limitation which indicates processing of orders.

4. Claims 1-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, the limitation "at least one business service method performs a function associated with the selected option" in independent method claim 50 is vague and indefinite. Independent claims 1, 19 and 36 contain similar enabling limitations (Claim 1 – "the at least one of the plurality of workflow processes is configured to invoke at least one of the plurality of business service methods to perform a function associated with the selected option."; Claim 19 – "generate a business object based on the portion of the service profile; and

Art Unit: 3692

a transformation engine wherein the transformation engine is configured to generate at least a portion of the complex object, and the transformation engine is further configured to perform the generation using the business object.”; Claim 36 – “the means for invoking the workflow process comprises a means for invoking at least one of the plurality of business service methods and the at least one of the plurality of business service methods is configured to perform a function associated with the selected option; means for receiving at least one of a service profile, quote information, and order information pertaining to an account from an external server; means for generating a business object”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito et al. (US Patent 6,587,838 B1) in view of Wiecha (US Patent 5,870,717) and Official Notice.

Re. Claims 1, 19, 36 & 50, Esposito discloses a method, system, apparatus, medium and data signal to enable users to interact with the system over heterogeneous network environments such as a packet switched network such as the Internet and a wireless network such as a plurality of pagers. At least one vendor computer is part of the system. The vendor computer has one or more databases for storing information about products and services in a product database, and a customer database, for storing information about customers. A plurality of client computers are part of the system. The client computers enable users to interact with the system to learn about and express interest in products and services. Thus, Esposito explicitly and implicitly discloses the processing of complex sales prospect inquiries and the complex customer purchase

Art Unit: 3692

orders (Abstract, ll. 1-6, 9-16). Esposito does not explicitly disclose the construction of the software for operating the vendor's system for processing complex customer inquiries and purchase orders, such as generating a customer portal, invoking a workflow process; receiving at least one of: a service profile, quote information pertaining to an account, generating a business object, and transforming at least a portion of the business object to a complex object. However, Wiecha discloses a computer-implemented method comprising: generating a list of accounts; selecting a selected account by detecting selection of one of the accounts, wherein the selecting a selected account is performed using a computer; generating a list of orders associated with the selected account, wherein the list of orders comprises orders that have been submitted to an external provisioning system for provisioning, and the computer and the external provisioning system are communicatively coupled to one another; selecting a selected order by detecting selection of one of the orders that has been submitted for provisioning by the external provisioning system, wherein the selecting a selected order is performed using the computer; detecting a request to make a change to the selected order, wherein the request comprises a change to the selected order; incorporating the change in the selected order; submitting a re-submitted order by submitting the selected order for provisioning by the external provisioning system; and, synchronizing the re-submitted order in the external provisioning system to override the one of the orders that had been submitted for provisioning.

The steps of generating a customer portal, a work flow process receiving of information from a customer pertaining to an account, the generating of a business object, and transforming a business object to a complex object would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention because they follow the logical order establishment steps disclosed, implied and suggested by Esposito, Wiecha and well known practices in the art of order placement and order acceptance. The only difference is the computer systems design terminology used by Applicant which represents generic business practices well known in the art of purchasing and customer service.

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention that the terminology used in the following steps is computer systems terminology describing generic business practices which are well known in the art of purchasing and customer service: generating a customer portal comprising a list of products and services associated with an account, a list of quotes associated with the account, a list of orders associated with the account, and a plurality of user-selectable options, wherein the customer portal is accessible by users including customer service representatives, customers, and service providers for the customers; invoking a workflow process, and the workflow process invokes at least one business service method to perform functions associated with the selected option; receiving at least one of: a service profile, quote information, and order information pertaining to an account; generating a business object based on the at least one of: a service profile, quote information, and order information; and transforming at least a portion of the business object to a complex object.

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Esposito, Wiecha and well known practices in order to produce a method, system, apparatus, medium and data signal for processing orders, motivated by a desire to provide real-time notifications to vendors of purchaser requirements in a heterogeneous network environment, and a virtual market place system that incorporates the human element in the purchase and sale transaction (Esposito, Col. 1, ll. 30-34, 60-62).

Re. Claims 2-18, 20-35, 37-49 and 51-63, neither Esposito nor Wiecha explicitly disclose the computer system steps in these dependent claims. However, the steps represent generically obvious steps of the well known order placement and order acceptance process, mixed with special terminology created by Applicant and which is defined in the specification, such as "Apply Method", Delta Method, Trim Method and Logical Delete Method, which are some of the special terms found in claim 52. Examples of other well known steps are Supplemental Orders Process in claim 53, Move Process in claim 54, and various other steps which are ordinary to the traditional order placement and order acceptance process. These steps, usually with their own

terminology labels, were well known to purchasing and customer service professional users at the time of Applicant's invention through the systems provided by many enterprise software suppliers, the best known of which were SAP, Baan and Oracle. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Esposito, Wiecha and well known practices in order to produce a method, system, apparatus, medium and data signal for processing orders, motivated by a desire to provide real-time notifications to vendors of purchaser requirements in a heterogeneous network environment, and a virtual market place system that incorporates the human element in the purchase and sale transaction (Esposito, Col. 1, ll. 30-34, 60-62).

Response to Arguments

5. Applicant's arguments filed August 15, 2007 have been fully considered but they are not persuasive.

ARGUMENT: Applicant argues that the examiner has failed to present a proper case of *prima facie* obviousness in the rejections made under the obviousness statute, 35 USC 103(a).

RESPONSE:

Applicant has made narrowly selective quotation or paraphrase of the 2007 US Supreme Court decision named KSR for short.

The examiner presents a summary of relevant key points for Applicant's convenience as presented by the Board of Patent Appeals and Interferences in July, 2007:

BPAI, *Ex parte* CATAN, Appeal 2007-0820, Decided: July 3, 2007

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

Art Unit: 3692

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which
9 Appeal 2007-0820 Application 09/734,808

a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12, 148 USPQ 459, 464 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

Art Unit: 3692

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at 1396.

In the instant case, the examiner has presented assessments of what the ordinary practitioner of the art would have known and would have derived by common sense at the time of Applicant’s invention. Applicant is referred to the prior art references and rationale presented in the above rejections. As such, the examiner considers that the above rejections meets the standards of a properly made *prima facie* case of obviousness rejection. The MPEP establishes a bar for Applicant to overcome in traversing the examiner's prior art references and rejection rationale. The examiner judges that Applicant's arguments fail to meet that bar.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3692

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or Faxed to (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

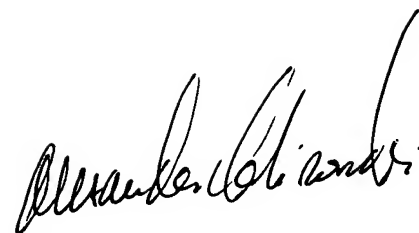
SEC

Application/Control Number: 10/024,691

Page 11

Art Unit: 3692

November 13, 2007

A handwritten signature in black ink, appearing to read "Alexander Kalinowski", written in a cursive style.

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER